

REMARKS

Claims 1-10 are pending in this application. Claim 1 is independent. Claim 10 is new.

Allowable Subject Matter

Applicant wishes to thank the Examiner for indicating that claim 9 contains allowable subject matter.

In any case, claim 9 has been amended to further recite the property of a thickness that is sufficient to suppress spurious signals. The claim as amended is supported by the specification at page 6, lines 12-19. Applicant submits that none of the references of record teach or suggest this claimed limitation.

Objection to the Specification

The specification had been objected to for a minor informality on page 1, lines 12-15, and a minor informality on page 6, lines 29-30. Applicant has amended the specification as requested. Accordingly, Applicant respectfully requests that the objection be withdrawn.

Objection to the Drawings

The specification, with respect to figures 4 and 13, as well as the drawings in figures 4, 5 and 8, have been objected to. Corrected formal

drawings are attached hereto. Applicant respectfully requests approval of the proposed drawing corrections.

In Fig. 4, the label "BRANCH" has been removed from the drawing rendering a description no longer necessary.

A description of reference label "246" has been included in the description of figure 13.

As had been previously noted, the sections shown in Figures 4 and 5 are regions. Thus, new numerical labels have been added in these figures and along with associated description in the specification.

Labels A and B have been added to the drawing in Figure 8.

Accordingly, Applicant respectfully requests that the objection to the drawings be withdrawn.

Claim Rejection - under 35 USC 112 and objection

Claims 4-7 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 2 has been objected to.

Claims 2, 4 and 6 have been amended appropriately. Accordingly, Applicant respectfully requests that the rejection/objection be withdrawn.

Claim Rejection – 35 USC 103; Figs 10-13, Kanada

Claims 1 and 2 have been rejected to over prior art disclosed in the present application and Kanda et al. (U.S. Patent 5,630,226). Applicant respectfully traverses this rejection.

The Office Action repeats this rejection from a previous Office Action, and further states that, “any function of spurious signal reduction has not been explicitly claimed.” In addition, the Office Action states that,

“As a final comment, it appears that one of the critical aspects distinguishing the applicants’ invention from that of the prior art is that to effect the shielding between the compartment and to provide spurious signal reduction, the partition must be of sufficient thickness as to function as a shield to prevent the spurious signal from coupling across the partition.”

In other words, the Office Action indicates that if the claim were to recite the function of reduction of a spurious signal, the Examiner would consider this as a distinguishing feature of the claimed invention. Thus, claim 1 has been amended to explicitly recite the solution to the problem of generation of a spurious signal in terms of the claimed arrangement and definition of spurious signal.

Applicant submits that claim 1 as amended clearly distinguishes over the disclosed prior art and Kanada, either alone or in combination.

Further with respect to claim 2, Applicant submits that Kanda and Figures 11 and 13 of the present application, either alone or in

combination, fails to teach or suggest the claimed, “said second printed circuit board is provided with a third hole in a peripheral region, along a furthest one of sides of said second board with respect to said second local oscillation circuit.”

Applicant respectfully requests that the rejection be withdrawn.

Claim Rejection – 35 USC 103; Kanada and Saitoh

Claims 3 and 8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art disclosed in the present application, Kanda, and further in view of Saitoh et al. (U.S. Patent 4,353,132). Applicant respectfully traverses this rejection.

With respect to dependent claims 3 and 8, at least for the reasons set forth above for claim 1, Applicant submits that claims 3 and 8 are not obvious as well. In addition, with respect to claim 8, Applicant submits that Kanda and Saitoh, either alone or in combination, fail to teach or suggest the claimed, “shaft portion protrudes from the second board to an extent that a spurious signal due to the two local oscillation circuits is precluded.” [emphasis added]

The Office Action states that, “the shaft portion extends beyond the circuit board (much in the same manner as applicant’s pin) and as such would have inherently function in the same manner as applicant’s contact pin in suppressing undesired spurious signals.” Applicant believes that this statement reflects a misunderstanding of the present

invention. In particular, it appears that the claim has been interpreted such that a longer shaft portion that extends beyond the circuit board is more beneficial in suppressing undesired spurious signals. **To the contrary, the present claimed invention is specifically limited to protrusion to an extent that a spurious signal is precluded, i.e., a short protrusion.** Neither Kanda or Saitoh address the problem of a spurious signal from simultaneous operation of two oscillator circuits. Furthermore, Saito does not disclose a specific length of the conductor rods 23 and 24. Thus, Applicant submits that insufficient evidence of inherency is provided by the Office Action.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. "The PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on 'prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same." *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

Accordingly, Applicant submits that the rejection fails to establish *prima facie* obviousness and respectfully requests that the rejection be withdrawn.

Claim Rejection - 35 USC 103; disclosed prior art, Kanda, Nakamura

Claims 4 and 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed in the present application, Kanda, and further in view of Nakamura (U.S. Patent 5,584,064). Applicant respectfully requests that the rejection be withdrawn.

Applicant submits that Nakamura also does not address the problem of a spurious signal and does not make up for the deficiencies of the prior art disclosed in the present application and Kanda. Thus, Applicant submits that the rejection fails to establish *prima facie* obviousness for claims 4 and 5, as well.

Claim Rejection - 35 USC 103; disclosed prior art, Kanda, Nakamura

Claims 6 and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed in the present application, Kanda, and further in view of Nakamura (U.S. Patent 6,472,958, hereinafter Nakamura 2). Applicant respectfully requests that the rejection be withdrawn.

Applicant submits that Nakamura 2 also does not address the problem of a spurious signal and does not make up for the deficiencies of the prior art disclosed in the present application and Kanda. Thus,

Applicant submits that the rejection fails to establish *prima facie* obviousness for claims 6 and 7, as well.

New Claim

Claim 10 has been added. Claim 10 recites a contributing feature to the reduction of spurious signal of a metal chassis of sufficient thickness. For at least the same reason as above for claim 1, Applicant submits that the prior art of record fails to teach each and every claimed feature of claim 10, as well.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert W. Downs (Reg. No. 48,222), to conduct an interview in an effort to expedite prosecution in connection with the present application.

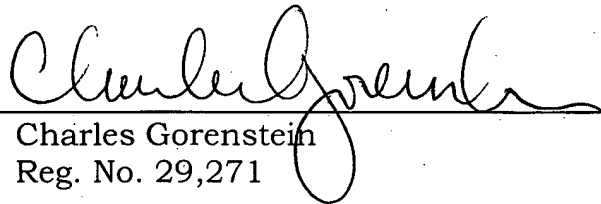
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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